

Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 1, 2, 4-6, 14, 15, and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,948,084, to Ha in view of U.S. Patent no. 6,311,282, to Nelson, et al.

In one embodiment of Applicant's invention, a hand-held controller is provided that is used to activate power up of a computer. Furthermore, depending on the button that was selected on the controller, a user may request that one of a variety of different applications be loaded and executed in the computer after power up.

Ha generally describes a remote control for controlling certain application software on a powered up and operational computer. In the Office Action, the Examiner stated that Ha describes an on/off button to perform power on sequence of the computer. Applicant respectfully disagrees. Applicant respectfully submits that Ha describes providing an on/off button for controlling application software on the computer system 20, and not the computer system itself. See Ha, col. 3, lines 26-40.

Furthermore, Applicant respectfully submits that the cited references fails to teach or suggest the limitation in Claim 1 "wherein said hand-held controller comprises at least one assigned button for actuating said signal." As is recited in Claim 1, the computer "is configured to perform a power on sequence and to launch a user-defined application program in response to receiving said signal." Ha and Nelson, in isolation or in combination, do not describe assigning a button for (i) activating power up and launching a user-defined application program. Similar limitations are recited in independent Claims 8, 10, 11, 14, and 17-19, as amended. Even if the systems of Ha and Nelson, were combined, it would not derive the claimed invention. Applicant respectfully submits that neither Ha or Nelson teach or suggest providing an *assigned* button on a hand-held controller for initiating power-on on a computer.

In the Office Action, the Examiner stated "[i]t would have been obvious to one of ordinary skill in the art to configure the transmitter and receiver for radio frequency transmission in Ha as evidenced by Nelson et al. because Ha suggests a computer system with wireless remote controller and Nelson et al. teaches a RF modem receiving command messages that enables the control of a computer by a portable unit and radio frequency communication is widely used as a means of transmitting signal between a transmitter and receive [sic]." Applicant submits that the Examiner's finding does not support a prima facie rejection. Applicant submits that the prior art

must suggest the desirability of the claimed invention. *See* M.P.E.P. § 2143.01. The fact that references can be modified is not sufficient to establish *prima facie* obviousness. *Id.* Furthermore, the fact that the claimed invention is within the capability of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. *Id.* In this case, the Examiner has merely made conclusory findings regarding the motivation to modify the Ha system. Applicant respectfully submits that the Examiner has failed to provide a *prima facie* rejection and that independent Claims 1, 8, 10, 11, 14, and 17-19 are in condition for allowance.

Furthermore, Applicant submits that it is improper to combine references where the references teach away from their combination.¹ The Court of Appeals for the Federal Circuit has stated that a reference teaches away if a "person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference."² Additionally, to support a rejection under 35 U.S.C. § 103(a), the Examiner may not "pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art."³ Appellant submits that the Examiner in this case has failed to give due consideration to the disclosure of Ha that teaches away from its combination with Nelson. Applicant respectfully submits that for direct and local communication with a computer, one would not turn to more complex and costly system, such as RF modems and pagers, which require access to remote communication networks.

Applicant respectfully submits that since neither Ha and Nelson do not teach or suggest in isolation or in combination at least the above limitations, these claims are in condition for allowance. Furthermore, Since claims 2, 4-7, 9, 12, 13, and 15-16 each depend on at least one of Claims 1, 8, 10, 11, 14, and 17, Applicant respectfully submits that the claims are allowable for at least the reasons discussed above.

Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes,

¹ *See In re Grasselli*, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983).

² *In re Gurley*, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994).

³ *In re Wesslau*, 147 U.S.P.Q. 391, 393 (CCPA 1965).

Appl. No. : 09/574,736
Filed : May 18, 2000

the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and the claims would satisfy the statutory requirements for patentability without the entry of such amendments. In addition, such amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

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Dated: 1/30/2000

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

1. (Amended) A remote controlled computer system, comprising:
a computer comprising a wireless receiver;
a hand-held controller comprising a wireless transmitter;
wherein said hand-held controller is configured to send a signal to said wireless receiver upon user actuation, and wherein said computer is configured to perform a power on sequence and to launch a user-defined application program in response to receiving said signal, wherein said wireless receiver and wireless transmitter have a communication range of approximately 200 to 500 feet, and wherein said hand-held controller comprises at least one assigned button for actuating said signal.
5. (Amended) A method of remotely controlling a computer comprising transmitting a signal from a hand-held controller to said computer, and in response thereto, placing said computer in an on state and launching a user specified application program, and wherein said hand-held controller comprises at least one assigned button for actuating said signal.
11. (Amended) A remote control device for a personal computer comprising a hand-held housing containing wireless signal transmission circuitry for communicating with wireless signal receiving circuitry in said personal computer, wherein said housing comprises an attachment device for connecting said remote control device to a key ring, purse handle, or other commonly carried personal item, and wherein said hand-held controller comprises at least one assigned button for actuating said signal.
17. (Amended) A computer system comprising:
a computer comprising a power supply and a storage device storing application programs;
and
hand-held remote control means for activating said power supply and launching a selected one of said application programs from a distance of approximately 200 to 500 feet, and wherein said hand-held controller comprises at least one assigned button for initiating a power up of the computer.